

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 29973
	:	
Thomas DISTEFANO III	:	Confirmation Number: 8542
	:	
Application No.: 09/589,551	:	Group Art Unit: 3688
	:	
Filed: June 7, 2000	:	Examiner: D. Lastra
	:	
Appeal No. 2009-000339	:	
	:	
For: METHOD FOR DEVELOPING ELECTRONIC DOCUMENTS PROVIDING E-COMMERCE TOOLS		

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated June 15, 2009 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellant respectfully submits that in the Decision on Appeal, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellant in the Appeal Brief of November 19, 2007, and in the Reply Brief of June 4, 2008. Appellant will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000).

Claim 1

Independent claim 1 recites the following limitations:

during design of the first website, receiving
information at a user interface indicating a type of an element for
marketing that is to be displayed at the second website, and
information specifying the second website at which the element is
to be displayed.

On page 2 of the Decision, the Honorable Board identified these limitations as "limitation [1]." Regarding limitation [1], the Examiner asserted the following on page 12, lines 16-22:

This information is received at the user interface prior to final approval (FF 10) and is therefore during the design of the website, or at least that particular advertising piece of the second website. The design of any aspect of a web site is a component of the design of the web site itself and thus fits the limitation of

occurring during design of the web site. We therefore find the Examiner's position that Mason describes limitation [1] supported by substantial evidence.

Appellant respectfully submits that the Honorable Board's analysis has erred in at least two respects. First, the Examiner did not allege that Mason describes all of limitation [1]. Referring to the fourth full paragraph on page 3 of the Fourth Office Action and to the third to last full paragraph on page 3 of the Examiner's Answer, the Examiner only asserted that Mason teaches the language "receiving to be displayed" from limitation [1]. Absent from the Examiner's statements, however, is an assertion that Mason teaches the "during design of the first website" aspect of limitation [1].

Instead, referring to page 3 of the Fourth Office Action and page 5 of the Examiner's Answer, the Examiner specifically asserted:

Mason does not expressly teach *during the design of the first website* causing the display of the element for marketing at the second website when the first website is activated with respect to the internet. (italics added)

The phrase "during the design of the first website" only occurs once in claim 1, and thus, the Examiner's assertion of what Mason does not teach refers to the recitation of this phrase within limitation [1]. Therefore, how the Honorable Board characterized the Examiner's position and the Examiner's explicitly stated position in the Fourth Office Action and in the Examiner's Answer are not the same.

1
2
3 Additionally, with regard to the claimed "during the design of the first
4 website," Appellant presented extensive arguments in the paragraph spanning on
5 pages 6 and 7 of the Appeal Brief that the Examiner has mischaracterized the
6 differences between the claimed invention and the prior art (i.e., one of the Graham
7 factual inquiries) by associating the "during the design of the first website" with
8 the "causing the display of the element for marketing at the second website when
9 the first website is activated with respect to the internet." The claimed "during the
10 design of the first website" modifies the step of "receiving information ..." and not
11 the step of "causing the display," as alleged by the Examiner. As a matter of logic,
12 if the first website is activated, the design of the first website has already been
13 completed. Thus, the step of "causing the display ..." does not occur "during the
14 design of the first website. The Honorable Board's Decision, however, does not
15 address this critical mischaracterization by the Examiner.
16
17

18 As reproduced above, on page 12, lines 19-20 of the Decision, the
19 Honorable Board presented the following analysis "[t]he design of any aspect of a
20 web site is a component of the design of the web site itself." Appellant has not

1 found this claim construction in the Examiner's analysis. As such, Appellant
2 presumes that this claim construction has been newly presented.

3
4 During patent examination, the pending claims must be "given their broadest
5 reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d
6 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The *broadest* reasonable
7 interpretation of the claims must also be consistent with the interpretation that one
8 skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d
9 1464, 1468 (Fed. Cir. 1999). Appellant respectfully submits that the Honorable
10 Board's claim construction is not reasonable and eviscerates any definite meaning
11 from the phrase "during the design of the first website."

12
13 The phrase "during" refers to a duration, which is the time during which
14 something exists or lasts. Thus, the phrase "during the design" refers to the time
15 during which the design of the first website lasts. For sake of argument, consider
16 what would occur if a website was being design for Bass Brewery. This website
17 includes Bass Brewery's trademark (i.e., including a red triangle) and the font used
18 in the website is Times New Roman. The Bass Brewery trademark has the
19 distinction of having one of the oldest trademarks (registered in 1875) and the
20 Times New Roman font was designed in 1931. The symbol of a triangle (i.e., "Δ")

1 dates back to at least 300 BC, in which Euclid discussed elementary facts about
2 triangles in books 1-4 of Elements.

3
4 If "[t]he design of any aspect of a web site is a component of the design of
5 the web site itself," then the duration that this hypothetical website was being
6 "designed" extends back nearly 24 centuries since a triangle falls under the
7 definition of "any aspect of a web site" as does a trademark displayed in the
8 website or a font used in the website. Appellant respectfully submit it is
9 unreasonable to construe the phrase "during the design of the first website" to
10 include durations that predate the birth of the website designer or the advent of the
11 internet.

12
13 Appellant respectfully submit that the phrase "during the design of the first
14 website" refers to the duration that starts when a designer makes an definitive step
15 to design the website and ends when the design of the website has been completed.
16 Otherwise, to construe that phrase in manner suggested by the Honorable Board,
17 this phrase would encompass periods when the design of the first website is
18 technically impossible (i.e., since the internet had not yet been invented) or the
19 design of the first website was not even contemplated by the designer.

Based upon Appellant's proposed definition, Appellant respectfully submit that the Honorable Board would reach the conclusion of both Appellant and the Examiner that Mason fails to teach the claimed "during the design," which is both contrary to and critical to the Honorable Board's analysis.

Claim 8

In the paragraph spanning pages 15 and 16 of the Decision, the Honorable Board presented the following analysis:

We disagree with the Appellant. A banner ad is simply a link in an HTML document. The contents of the ad are non-functional descriptive material and are accorded no patentable weight. *In re Ngai*, 367 F.3d at 1339. More shows such links (FF 04).

Upon reviewing the Examiner's appealed rejection in the Fourth Office Action dated June 18, 2009, and the Examiner's analysis in the Examiner's analysis, Appellant has been unable to identify any reliance upon In re Ngai by the Examiner. Since the Examiner failed to rely upon In re Ngai and the Honorable Board relies upon this case law to support the Honorable Board's analysis, this reliance upon In re Ngai represents a new ground of rejection. As such, designation as a new ground is necessary because Appellant has not had a fair opportunity to react to the thrust of the "affirmance" of the rejection, which is based upon case law that was not cited to Appellant until after the Decision had

1 been rendered by the Honorable Board. See In re Kumar, 418 F.3d 1361, 1367-68
2 (Fed. Cir. 2005) ("the ultimate criterion of whether a rejection is considered 'new'
3 in a decision by the board is whether appellants have had fair opportunity to react
4 to the thrust of the rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA
5 1976)).

6
7 The Honorable Board's reliance upon In re Ngai is misplaced. Both In re
8 Ngai and the related case of In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir.
9 1983), involved issues regarding printed matter. However, the claimed invention
10 does not involve printed matter. Instead, the claimed "banner ad" is a type of data
11 structure that includes more than just "simply a link in an HTML document," as
12 alleged by the Honorable Board. Banner ads also include a graphical image file
13 and a means to connect the link to a graphical image file. The banner ad can also
14 be animated, which requires a mechanism to do so or even be interactive with a
15 user input (e.g., a mouse). Thus, one skilled in the art would recognize the claimed
16 "banner ad" is a particular type of data structure that includes more than just a link.

17
18 Reference is made to the following discussion within In re Lowry, 32 F. 3d
19 1579, 1583, 32 USPQ 2nd 1031, 1034 (Fed. Cir. 1994), as to the differences
20 between a data structure and printed matter:

1 The printed matter cases “dealt with claims defining as the invention
2 certain novel arrangements of printed lines or characters, useful and
3 intelligible only to the human mind.” *In re Bernhart*, 417 F.2d 1395,
4 1399, 163 USPQ 611, 615 (CCPA 1969). The printed matter cases
5 have no factual relevance where “the invention as defined by the
6 claims *requires* that the information be processed not by the mind but
7 by a machine, the computer.” *Id.* (emphasis in original). Lowry’s data
8 structures, which according to Lowry greatly facilitate data
9 management by data processing systems, are processed by a machine.
10 Indeed, they are not accessible other than through sophisticated
11 software systems. The printed matter cases have no factual relevance
12 here.

13
14 As claimed, (i) a search request for banner ad designs is received at the user
15 interface; (ii) the results of the search are displayed on the user interface; (iii) and
16 the first banner ad design is selected via the user interface. Thus, the banner ad
17 design is information that is processed using a machine (e.g. a computer). Thus,
18 Appellant respectfully submit that the Honorable Board’s reliance upon In re Ngai
19 is misplaced. Moreover, as a result of the Honorable Board’s improper reliance
20 upon In re Ngai, the Honorable Board has not given patentable weight to full
21 meaning of the term “banner ad” and “banner ad design.” As argued on page 11 of
22 the Appeal Brief and on page 9 of the Reply Brief, not only has the Examiner
23 failed to establish that the applied prior art teaches the claimed banner ad or banner

1 ad design, the Examiner has failed to establish that applied prior art teaches any of
2 the other limitations associated with claim 8.

3

4 For the reasons set forth in the Appeal Brief and in the Reply Brief,
5 Appellant respectfully solicits the Honorable Board to reverse the Examiner's
6 rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 503839, and please credit any excess fees to such deposit account.

Date: August 17, 2009

Respectfully submitted,

/Scott D. Paul/

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CUSTOMER NUMBER 29973